

REMARKS

This Amendment is in response to the Office Action mailed on March 27, 2008, in which claims 19-23 and 42-75 were rejected. With this Amendment claims 19, 42, 52, 60, and 73-75 are amended. Applicant respectfully requests reconsideration of the present Application in view of the foregoing amendments and the reasons that follow.

1. Rejection of Claims 42-51 Under 35 U.S.C. § 101

On page 2 of the Office Action, the Examiner rejected claims 42-51 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Independent claim 42 has been amended to recite statutory subject matter. Independent claim 42 has been amended to recite that the first shaft is “configured to extend into an intramedullary canal of a bone of the patient,” and thus, does not positively recite part of a human. Independent claim 60 has been amended to recite that the “first shaft is configured to extend into a bone,” and thus, does not positively recite part of a human.

The Applicant requests withdrawal of the rejection under 35 U.S.C. § 101 of independent claim 42 and of corresponding dependent claims 43-51.

2. Rejection of Claims 42-48, 50-65, 67-69, 73, and 74 Under 35 U.S.C. § 102(e) as Anticipated by Dwyer et al.

On pages 2-3 of the Office Action, the Examiner rejected claims 42-48, 50-65, 67-69, 73, and 74 under 35 U.S.C. § 102(e) as anticipated by Dwyer et al., U.S. Patent No. 7,122,056. Applicant has amended independent claims 42, 52, and 60 to overcome the rejection based on Dwyer et al.

Independent claim 42, as amended, recites a “joint prosthesis system” including “a body having a first portion, a second portion, and a central canal, wherein the central canal extends through the second portion of the body” and “a head coupled to the first portion of the body.” Independent claim 52, as amended, recites a “modular joint prosthesis” including “a body having

a first portion, and a second portion, the first portion of the body coupled to the articular surface; and a shaft coupled to the second portion of the body.” Independent claim 60, as amended, recites a “modular joint prosthesis system” including “a body having a proximal segment, and a distal segment; an articular surface coupled to the proximal segment of the body; and a plurality of modular shafts comprising a first shaft ... configured to be coupled to the distal segment of the body.” The amendments to claims 42, 52, and 60 are supported by the application as originally filed. See e.g., Application, paragraph [0030] and Fig. 3.

Dwyer et al. does not identically disclose “a body having a first portion, a second portion, and a central canal, wherein the central canal extends through the second portion of the body” and “a head coupled to the first portion of the body” as recited in independent claim 42. Dwyer et al. does not identically disclose “a body having a first portion, and a second portion, the first portion of the body coupled to the articular surface; and a shaft coupled to the second portion of the body” as recited in independent claim 52. Dwyer et al. does not identically disclose “a body having a proximal segment, and a distal segment; an articular surface coupled to the proximal segment of the body; and a plurality of modular shafts comprising a first shaft ... configured to be coupled to the distal segment of the body” as recited in independent claim 60.

In contrast, Dwyer et al. discloses a “modular prosthesis 100” having a “sleeve component 14,” a “stem component 18,” and a “neck component 12” having a “trunnion 26” at one end that joins “neck component 12” to “head component 16.” See col. 15, lines 63-67, col. 5, lines 48-50, col. 6, lines 31-33, and Figs. 1 and 5. The “sleeve component 14” (identified as “the body” by the Examiner) includes an “elongated bore 36” that receives both the “stem component 18” and the “neck component 12.” Col. 6, lines 45-47 Thus, “head component 16” is joined to “sleeve component 14” via the connection of “neck component 12” to “elongated bore 36” of “sleeve component 14.”

Therefore, Dwyer et al. does not disclose “a body having a first portion, a second portion, and a central canal, wherein the central canal extends through the second portion of the body” and “a head coupled to the first portion of the body,” as recited in independent claim 42, “a body

having a first portion, and a second portion, the first portion of the body coupled to the articular surface; and a shaft coupled to the second portion of the body,” as recited in independent claim 52, or “a body having a proximal segment, and a distal segment; an articular surface coupled to the proximal segment of the body; and a plurality of modular shafts comprising a first shaft ... configured to be coupled to the distal segment of the body,” as recited in independent claim 60.

In view of the amendments to independent claims 42, 52, and 60 and the arguments set forth above, the Applicant respectfully asserts that independent claims 42, 52, and 60 and corresponding dependent claims 43-48, 50-51, 53-59, 61-65, 67-69, 73, and 74 are not anticipated by Dwyer et al. under 35 U.S.C. § 102(e).

3. Rejection of Claims 19-23 Under 35 U.S.C. § 103(a) Based Upon Ganjianpour

On pages 3-4 of the Office Action, the Examiner rejected claims 19-23 under 35 U.S.C. § 103(a) as unpatentable over Ganjianpour, U.S. Patent No. 6,716,250. Independent claim 19 has been amended to recite a combination of subject matter that the Applicant believes is allowable under 35 U.S.C. § 103(a).

Independent claim 19, as amended, recites a “method of replacing a shaft of a joint prosthesis having a body, a head, and a shaft after the joint prosthesis has been implanted in a patient, wherein the shaft has an outer surface adapted to interface with an intramedullary canal of the patient” including the step of “removing the shaft from the patient without removing both the body and the head.” Ganjianpour does not disclose, teach, or suggest a “method of replacing a shaft of a joint prosthesis” including the step of “removing the shaft from the patient without removing both the body and the head” where the joint prosthesis includes a shaft having “an outer surface adapted to interface with an intramedullary canal”

Ganjianpour discloses a “modular femoral prosthesis” having “a neck element 18,” a “stem element 12,” and “a grooved shaft 26.” Col. 7, lines 49-65 and Figs. 1 and 5. The “grooved shaft 26” of Ganjianpour has an outer surface adapted to interface with an inner surface of “stem

element 12,” and “stem element 12” is positioned beneath “neck element 18” such that removal of “stem element 12” would necessitate removal of “neck element 18.” See e.g., Fig. 5. The Applicant respectfully asserts that the “method of replacing a shaft of a joint prosthesis” recited in independent claim 19, as amended, would not have been obvious in view of Ganjianpour under 35 U.S.C. § 103(a).

In view of the amendments to independent claim 19 and the arguments set forth above, Applicant respectfully asserts that independent claim 19 and corresponding dependent claims 20-23 are patentable over Ganjianpour under 35 U.S.C. § 103(a).

4. Rejection of Claim 75 Under 35 U.S.C. § 103(a) Based Upon Dwyer et al.

On pages 4-5 of the Office Action, the Examiner rejected claim 75 under 35 U.S.C. § 103(a) as unpatentable over Dwyer et al. Independent claim 75 has been amended to recite a combination of subject matter that the Applicant believes is allowable under 35 U.S.C. § 103(a).

Independent claim 75, as amended, recites an “artificial joint system” including “a body having a first portion, a second portion, and a central canal defined therein, the central canal positioned through the second portion of the body” and “a prosthetic head coupled to the first portion of the body.” Dwyer et al. does not disclose, teach or suggest “a body having a first portion, a second portion, and a central canal defined therein, the central canal positioned through the second portion of the body” and “a prosthetic head coupled to the first portion of the body.”

In contrast, Dwyer et al. discloses a “modular prosthesis 100” having a “sleeve component 14,” a “stem component 18,” and a “neck component 12” having a “trunnion 26” at one end that joins “neck component 12” to “head component 16.” See col. 15, lines 63-67, col. 5, lines 48-50, col. 6, lines 31-33, and Figs. 1 and 5. The “sleeve component 14” (identified as “the body” by the Examiner) includes an “elongated bore 36” that receives both the “stem component 18” and the “neck component 12.” Col. 6, lines 45-47 Thus, “head component 16” is joined to “sleeve component 14” via the connection of “neck component 12” to “elongated

bore 36” of “sleeve component 14.” The Applicant respectfully asserts that the “artificial joint system” recited in independent claim 75, as amended, would not have been obvious in view of Dwyer et al. under 35 U.S.C. § 103(a).

In view of the amendments to independent claim 75 and the arguments set forth above, Applicant respectfully asserts that independent claim 75 is patentable over Dwyer et al. under 35 U.S.C. § 103(a).

5. Rejection of Dependent Claims 49, 51, 57, 66, and 70-72 Under 35 U.S.C. § 103(a) Based Upon Dwyer et al.

On pages 4-5 of the Office Action, the Examiner rejected claims 49, 51, 57, 66, and 70-72 under 35 U.S.C. § 103(a) as unpatentable over Dwyer et al. As discussed above, Dwyer et al. does not disclose “a body having a first portion, a second portion, and a central canal, wherein the central canal extends through the second portion of the body” and “a head coupled to the first portion of the body,” as recited in independent claim 42, “a body having a first portion, and a second portion, the first portion of the body coupled to the articular surface; and a shaft coupled to the second portion of the body,” as recited in independent claim 52, or “a body having a proximal segment, and a distal segment; an articular surface coupled to the proximal segment of the body; and a plurality of modular shafts comprising a first shaft ... configured to be coupled to the distal segment of the body,” as recited in independent claim 60.

Accordingly, Applicant respectfully asserts that claims 49 and 51, which depend from independent claim 42, claim 57, which depends from independent claim 52, and claims 66 and 70-72, which depend from independent claim 60, are patentable over Dwyer et al. under 35 U.S.C. § 103(a).

6. Amendments to Claims 73 and 74

Applicant has amended claims 73 and 74 to maintain consistency with amended independent claim 60. Applicant respectfully asserts that dependent claims 73 and 74, as amended, are patentable.

7. Conclusion

Claims 19-23 and 42-75 are pending in the present application. Claims 19, 42, 52, 60, and 73-75 have been amended. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application, as amended, is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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